



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,919	06/25/2003	Yasutaka Tsuru	62758-041	6010

7590 04/11/2008
McDermott, Will & Emery
600, 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

JONES, HEATHER RAE

ART UNIT	PAPER NUMBER
----------	--------------

2621

MAIL DATE	DELIVERY MODE
-----------	---------------

04/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/602,919	Applicant(s) TSURU ET AL.	
	Examiner HEATHER R. JONES	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 and 09 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/10/2007</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 25, 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-3, 6-8, and 10-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 6 is objected to because of the following informalities: it depends from a canceled claim. It appears to the Examiner it should depend from claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6-8, and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (U.S. Patent Application Publication 2003/0037068) in view of Candelore et al. (WO 03/090401) in view of Proehl (U.S. Patent 6,614,844).

Regarding claim **1**, Thomas et al. discloses a video recording/playback system for recording and playback of video data received, comprising: a memory (46) which receives and stores video data which consists of sets of main data and sub data falling under different categories, the sets of main data and sub data being associated and sequenced along a time axis (Fig. 1, paragraphs [0024], [0027], [0030], [0044], and [0073] – television programs (main data) along with advertisements (sub data) are being sent to the system); a playback unit which reads out main data and sub data from the memory and renders video contents of these data (Fig. 9, paragraphs [0071] – [0073], and [0078]), and a controller that judges whether or not the main data has been paused or fast-forwarded and follows the media data accordingly (paragraphs [0027]).

However, Thomas et al. fails to disclose video data which consists of sets of main data and sub data falling under different categories, wherein the sets of main data and sub data being associated and sequenced along time axis, wherein in a set of main data and sub data an ID code and substitute data are embedded in advance, said ID code identifying said set of main data and sub data, said substitute data being associated with said sub data, and the same ID code as assigned to said main data is assigned to said sub data; and a controller which, when the main data stored in the memory is rendered, detects an ID code

assigned to the main data, compares the detected ID code with an ID code assigned to the sub data stored in the memory and judges whether the sub data associated with the main data under rendering has already been read from the memory and its video rendered and, unless the sub data video has been rendered, changes substitute data embedded in the main data and associated in advance with the sub data into video data and incorporates the substitute data into the main data and makes the video data render when the main data is rendered.

Referring to the Candelore et al. reference, Candelore et al. discloses a video recording/playback system for recording and playback of video data received, comprising: a memory which receives and stores video data which consists of sets of main data and sub data falling under different categories (Figs. 2 and 3), the sets of main data and sub data being associated and sequenced along a time axis; video data which consists of sets of main data and sub data falling under different categories, the sets of main data and sub data being associated and sequenced along time axis wherein in a set of main data and sub data an ID code and substitute data are embedded in advance, said ID code identifying said set of main data and sub data, said substitute data being associated with said sub data, and the same ID code as assigned to said main data is assigned to said sub data (Fig. 4; page 10, line 30 – page 11, line 24); and a playback unit which reads out main data and sub data from the memory and renders the video contents of these data (Figs. 2 and 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided main data and sub data with the same ID code as disclosed in Candelore et al. with the apparatus disclosed by Thomas et al. in order to easily associate the sub data that goes with the main data. However, Thomas et al. in view of Candelore et al. still fail to disclose a controller which, when the main data stored in the memory is rendered, detects an ID code assigned to the main data, compares the detected ID code with an ID code assigned to the sub data stored in the memory and judges whether the sub data associated with the main data under rendering has already been read from the memory and its video rendered and, unless the sub data video has been rendered, changes substitute data embedded in the main data and associated in advance with the sub data into video data and incorporates the substitute data into the main data and makes the video data render when the main data is rendered.

Referring to the Proehl reference, Proehl discloses a system comprising: playback means for reading main data and sub data and rendering video contents of these data (col. 1, lines 33-53), comprising: a controller which, when the main data stored in the memory is rendered, judges whether the sub data associated with the main data under rendering has already been read from the memory and its video rendered and, unless the sub data video has been rendered, changes substitute data embedded in the main data and associated in advance with the sub data into video data and incorporates the substitute data

Art Unit: 2623

into the main data and makes the video data render when the main data is rendered (Fig. 3E – substitute data from the previous commercial that was not rendered is rendered with the main data; col. 1, lines 38-50; col. 2, lines 32-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have not only added special instructions during pause modes to display certain images as disclosed by Thomas et al. but to have added special instructions regarding fast-forwarding that allows the user to display extra information as disclosed by Proehl in the device disclosed by Thomas et al. in view of Candelore et al. in order to allow advertisers to still promote their product or service even though their commercial is being fast-forwarded. Furthermore, with the use of the assigned ID codes disclosed by Candelore the judging means will easily be able to decipher if the commercial was rendered and which part of the main data should display the substitute data.

Regarding claim **2**, Thomas et al. in view of Candelore et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the main data is program data and the sub data is commercial data (Thomas et al.: paragraphs [0024], [0027], [0030], [0044], and [0073] – television programs (main data) along with advertisements (sub data) are being sent to the system; Proehl: Fig. 3; col. 2, lines 61-65; col. 3, lines 1-3).

Regarding claim **3**, Thomas et al. in view of Candelore et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1 and 2 including that the main data and the sub data includes attribute data

which judges the attribute of the set of main data and sub data and the controller judges by the detected ID code and the attribute data whether the sub data has been rendered (Candelore et al.: Figs. 2 and 3; Proehl: Fig. 2 – header information; col. 2, lines 31-57 – the metadata includes all necessary information regarding the way content is displayed on the screen).

Regarding claim **6**, Thomas et al. in view of Candelore et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-5 including that the main data includes substitute information rendering limit data for setting a limit to rendering the substitute data (Proehl: col. 2, lines 32-57 – the embedded data is only displayed for a certain time and not throughout the rest of the program).

Regarding claim **7**, Thomas et al. in view of Candelore et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-6 including that the substitute information rendering limit data is specified so that the substitute data will be rendered in a certain range of frames of the main data associated with the sub data which has not been rendered (Proehl: col. 2, lines 32-57 – the embedded data is only displayed for a certain time and not throughout the rest of the program; col. 3, lines 16-23 - the metadata includes the instructions on how and when the watermark data is to be displayed).

Regarding claim **8**, Thomas et al. in view of Candelore et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-6 including that wherein, as the substitute information rendering limit data, the

number of times the substitute data is to be rendered or a time range within which the substitute data is to be rendered are set (Proehl: col. 2, lines 32-57 – the embedded data is only displayed for a certain time and not throughout the rest of the program; col. 3, lines 16-23 - the metadata includes the instructions on how and when the watermark data is to be displayed).

Regarding claim **10**, Thomas et al. in view of Candelore et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the main data includes a substitute data address instead of the substitute data, the substitute data address specifying where the substitute data has been stored in advance on the memory or another memory on a network (Thomas et al: paragraph [0025] – media distribution facility and media data database).

Regarding claim **11**, Thomas et al. in view of Candelore et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the input of a cancel code for disabling the rendering of the substitute data makes it impossible for the controller to incorporate the substitute data into the main data and render main video accompanied with the substitute data (Thomas et al: Figs. 7 and 8; paragraphs [0071] – [0077]).

Regarding claim **12**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the substitute data is the name of an advertiser, a corporate logo, or a commodity name to advertise which substitutes for the main data (Proehl: Figs. 3D-3F).

Art Unit: 2623

Regarding claims **13-16**, these are method claims corresponding to the apparatus claims 1-3. Therefore, claims 13-16 are analyzed and rejected as previously discussed with respect to claims 1-3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEATHER R. JONES whose telephone number is (571)272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/

Heather R Jones

Application/Control Number: 10/602,919

Page 10

Art Unit: 2623

Supervisory Patent Examiner, Art Unit 2623

Examiner
Art Unit 2621

HRJ

March 30, 2008